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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,665	10/03/2003	Thomas Rumpf	RUMPF ET AL-4	9747

7590 02/13/2007
Kurt Kelman
COLLARD & ROE, P.C.
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Roslyn, NY 11576

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/678,665

Applicant(s)

RUMPF ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-24-07 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1-3** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 now recites the limitation "without further mechanical operations" which is not supported by the original disclosure. Although there is support for "application of the anti-friction coating without reprocessing of the anti-friction coating" (see last paragraph of page 2 of

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applicant's specification), the original disclosure does not specifically preclude further "mechanical" operations.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 1-3** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, "the production" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-2** are rejected under 35 U.S.C. 102(b) as being anticipated by Bank et al. (US6312579).

Bank et al. teach a method of producing a workpiece having at least one bearing eye (col. 2, line 65, "crank shaft"), the surface of the bearing eye being coated with an anti-friction coating **24 or 124** made of an alloy of a harder alloy component (col. 2, line 33) and a softer alloy

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component (col. 2, line 30), characterized in that the bearing eye surface is processed ("processed" is the manufacturing method used to create **12,16** which is a bearing eye surface) for a precise fit to a circular cylinder (a crank shaft bearing eye is considered a circular cylinder), and the production is then finished without further mechanical operations (Bank et al. do not disclose any mechanical operations after the coating is applied and is considered to meet this limitation) by applying the anti-friction coating **24 or 124** to the processed bearing eye surface in a thickness corresponding to the final dimensions, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness (col. 4, lines 4-5 and 49-51). The anti-friction coating is galvanically deposited, with the strength of the electrical field used for depositing being varied (col. 3, lines 44-52).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnhold et al. (US5551782) in view of Bank et al. (US6312579).

Arnhold et al. teach a method of producing a workpiece having at least one bearing eye, the surface of the bearing eye being coated with an anti-friction coating **15** made of an alloy component, characterized in that the bearing eye surface is processed for a precise fit to a

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circular cylinder (col. 1, lines 40-47, the bearing eye surface is processed by machining to create a circular cylinder), and the production is then finished without further mechanical operations (col. 2, line 45) by applying the anti-friction coating **15** to the processed bearing eye surface in a thickness corresponding to the final dimensions.

Arnhold et al. teach the invention cited above with the exception of the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness.

Bank et al. teach the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness (see citations in the 102(b) rejection above).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Arnhold et al. with the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness, in light of the teachings of Bank et al., in order to provide a desired conformability, embedibility and fatigue resistance as suggested by Bank et al.

Arnhold et al. teach that the anti-friction coating is divided according to fracture separation.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. **Claims 1-3** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7178238 in view of Bank et al..

The '238 patent claims essentially the same invention as claims 1-3 of the instant application, with the exception of specifically claiming that the surface of the bearing eye is coated with an anti-friction coating made of an alloy of a harder alloy component and a softer alloy component and the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness.

Bank et al. teach the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness (see citations in the 102(b) rejection above).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of the '238 patent with the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer

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alloy component in the deposited alloy being increased with increasing coating thickness, in light of the teachings of Bank et al., in order to provide a desired conformability, embeddibility and fatigue resistance as suggested by Bank et al.

12. **Claims 1-3** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-8 of copending Application No. 10/678,668 in view of Bank et al..

The '668 application claims essentially the same invention as claims 1-3 of the instant application, with the exception of specifically claiming that the surface of the bearing eye is coated with an anti-friction coating made of an alloy of a harder alloy component and a softer alloy component and the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness.

Bank et al. teach the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness (see citations in the 102(b) rejection above).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of the '668 application with the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness, in light of the teachings of Bank et al., in order to provide a desired conformability, embeddibility and fatigue resistance as suggested by Bank et al.

This is a provisional obviousness-type double patenting rejection.

13. **Claims 1-11** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 4-8 of copending Application No. 10/678,669 in view of Bank et al..

The '669 application claims essentially the same invention as claims 1-3 of the instant application, with the exception of specifically claiming that the surface of the bearing eye is coated with an anti-friction coating made of an alloy of a harder alloy component and a softer alloy component and the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness.

Bank et al. teach the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness (see citations in the 102(b) rejection above).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of the '669 application with the anti-friction coating made of an alloy of a harder alloy component and a softer alloy component, the proportion of the softer alloy component in the deposited alloy being increased with increasing coating thickness, in light of the teachings of Bank et al., in order to provide a desired conformability, embeddibility and fatigue resistance as suggested by Bank et al.

This is a provisional obviousness-type double patenting rejection.

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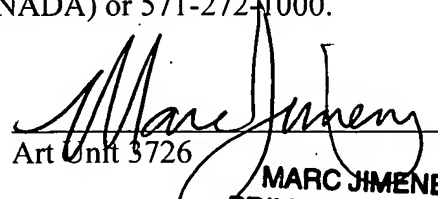
Response to Arguments

14. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is (571) 272-4530. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Art Unit 3726
MARC JIMENEZ
PRIMARY EXAMINER

MJ
2-6-07